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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,933	12/21/2001	Marc Nazare	02481.1779-00000	7773

5487 7590 06/16/2004

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EXAMINER

KUMAR, SHAIENDRA

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/023,933	<b>Applicant(s)</b> NAZARE ET AL.	
	<b>Examiner</b> SHAIENDRA - KUMAR	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/7/04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/3/02, 6/27/02, 1</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to applicants' communication filed on 4/7/04.

Claims 1-21 are pending in this application.

1. Applicant's election with traverse of Group VX, claims 1-21 in the reply filed on 4/7/04 is acknowledged. The traversal is on the ground(s) that the examiner cannot restrict applicants' invention unless examination of the claims results in serious burden, and in the present case, the examiner has not shown that there would be serious burden to examine at least some of the alleged 39 inventions together in a single invention. Applicants further point out that the examiner has not further classified the groups hence examiner can not conclude that there is undue burden. This is not found persuasive because it is clear from the claims that there is no common core present. The definitions of various groups are so vast that the classification itself is undue burden, leave alone the examination. Examiner has pointed out clearly the reasons for the restriction requirement. 1) Divergent chemical groups, and 2) classified in various class and subclass, and it was pointed out that there are numerous class and subclass depending on the compound that can be made out of the generic claims. Additionally, the examiner has pointed out that a reference anticipating one of the 39 groups would not render others obvious under 35 USC 103. Applicants' allegation that at least some of the groups can be examined together, is not found persuasive, because there is no common core present.

The requirement is still deemed proper and is therefore made FINAL.

***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on 12/23/2000. It is noted, however, that applicant has not filed a certified copy of the EPO application as required by 35 U.S.C. 119(b).

***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 12/21/2001, 4/3/2002, and 6/27/2002 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

4. **The species of example 199, see specification, pages 173-175, is free of prior art and is allowable.**

5. **US 5,753,659(Mills) is cited to show the state of the art.** See column 8, line 50, column 7, line 47-48, and column 4, line 14 and 29-30. The sole difference between the reference and herein claimed species is that A1 in the reference is carboxyl group as against substituted phenyl in herein.


6. Claims 1-21 are objected to as containing subject matter of non-elected inventions of I-IVX and VXI-39, but would be allowable, subsequent to the cancellation of non-elected subject matter, that is group I-IVX and VXI-39.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA - KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SHAILENDRA KUMAR  
Primary Examiner  
Art Unit 1621

S.Kumar  
6/10/04